REMARKS/ARGUMENTS

Claims 1 and 4-14 are pending in this application and presented for examination. Claims 1 and 6 have been amended. Claims 2 and 3 have been canceled without prejudice and their features have been incorporated into claims 1 and 6. Claims 7-14 are newly added. No new matter has been introduced with the foregoing amendments and newly added claims. Reconsideration is respectfully requested.

I. FORMALITIES

Claims 1 and 6 have been amended by incorporating the features of claims 2 and 3. Claims 7-14 are newly added and find support throughout the application as originally filed. More particularly, support for claims 7-14 is found, for example, in claim 1 as filed; pages 5 and 6, wherein definitions for a water-insoluble polymer and an enterosoluble polymer are found; and page 7, wherein support for a film, matrix and a combination film and matrix is found. As such, no new matter has been introduced with the foregoing amendments and newly added claims. Therefore, Applicants respectfully request that they be entered.

II. REJECTION UNDER 35 U.S.C. § 103(a)

The Examiner rejected claim 1-6 under 35 U.S.C. § 103(a) as allegedly being obvious over EP 1 125 576 A1 ("Ishibashi *et al.*"), in view of EP 0 745 382 A1 ("Mizumoto *et al.*"). To the extent the rejection is applicable to the amended set of claims, Applicants respectfully traverse the rejection.

As set forth in M.P.E.P. § 2143:

> [t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

I*n re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)

All three elements set forth above must be present in order to establish a *prima facie* case of obviousness. Applicants assert that a *prima facie* case of obviousness has not been established for the following reasons: 1) there is no suggestion or motivation to modify the references; 2) there is no reasonable expectation of success; and 3) the cited art references do not teach or suggest all the claim limitations.

1. There is no Suggestion or Motivation to Modify the References

Applicants state that there is simply no motivation or suggestion provided in the cited references to modify their teaching in the way the Office Action has contemplated. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Recently, the U.S. Supreme Court affirmed *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966) and indicated that the idea underlying the teaching, suggestion, or motivation (TSM) test is not inconsistent with the *Graham* analysis. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739-1741 (2007). In fact, the Court recognized that the TSM test provides a helpful insight in determining whether the claimed subject matter is obvious over a combination of prior art elements. *KSR*, 127 S.Ct. at 1741. *See also*, page 1 of the USPTO KSR Memorandum dated May 3, 2007. The Court also noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR*, 127 S.Ct. at 1740-1741. *See also*, page 2 of the USPTO KSR Memorandum.

Claim 1 of the present invention provides:

> An enteric sustained-release fine particles for tablets that disintegrate in the buccal cavity, which comprise (1) tamsulosin or its salt and at least (2) an enterosoluble polymer and or a higher fatty acid, and when necessary contain (3) a water-insoluble polymer and or wax, which particles have the following characteristics:
> 1) a particle diameter of approximately 5 to 250 μm; and
> 2) a dissolution characteristic such that when dissolution tests in accordance with the Japanese Pharmacopoeia are performed on tablets containing these particles,
> a) the dissolution rate of tamsulosin or its salt at a pH of 1.2 two hours after starting tests is 25% or less; and
> b) the time when 50% of the tamsulosin or its salt has dissolved at a pH of 6.8 is 0.5 to 5 hours, wherein said tablet used in the dissolution test is made from said enteric sustained-release fine particles.

The present claims are focused on enteric sustained-release fine particles for tablets disintegrating in the buccal cavity comprising tamsulosin or its salt, displaying good disintegration in the buccal cavity while avoiding a gritty feeling, and having a dissolution profile that is appropriate for tamsulosin and its salts. As explained in the specification on pages 3 and 4, the enteric sustained-release fine particles of the invention, which are smaller than ordinary granule preparations, reduce the gritty feeling in the buccal cavity while still exhibiting good disintegration in the buccal cavity and obtaining a dissolution profile that is appropriate for tamsulosin and its salts.

Ishibashi *et al.* teach a method for producing particles having a high drug content, small particle size, high sphericity, smooth surface and a coated form for the production of easily-swallowed controlled-release preparations. Ishibashi *et al.* relate to a preparation method of drug-containing spherical fine particles having a mean particle size of 200 μm or less comprising adding a binder solution to a mixture containing an excipient powder having the property of retaining a solvent and the drug powder, and granulating by high-speed mixing.

As the Examiner has pointed out, Ishibashi *et al.* do not teach or suggest tamsulosin or a tamsulosin salt as is currently claimed. Further, there is no teaching or suggestion of a tablet which disintegrates in the buccal cavity.

Mizumoto *et al.* teach intrabuccally dissolving compressed tablets comprising a low moldability saccharide having been granulated with a high moldability saccharide. The

tablets show quick disintegration and dissolution in the buccal cavity with adequate hardness. As discussed on page 5, lines 17-19:

> Thus, according to the present invention, there is provided an intrabuccally dissolving compressed molding capable of quickly disintegrating and dissolving in the buccal cavity, which comprises a low moldability saccharide and another high moldability saccharide.

According to the teaching of Mizumoto *et al.*, the tablet quickly disintegrates and dissolves in the buccal cavity, wherein the active ingredient is released.

The combination of cited art does not render the present invention obvious as the claims are drawn to enteric sustained-release fine particles for tablets that disintegrate in the buccal cavity, which comprise (1) tamsulosin or its salt and at least (2) an enterosoluble polymer and or a higher fatty acid, and when necessary contain (3) a water-insoluble polymer and or wax, which particles having a specific dissolution profile. Although the tablets disintegrate in the buccal cavity, the particles are enterically coated and thus are sustained release. As obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, the present claims are unobvious.

In the present invention, it is necessary to prevent sudden dissolution in order to control the adverse effect of orthostatic hypotension of tamsulosin. In this regard, the Examiner's attention is respectfully directed to page 3, penultimate line, of the present specification. As this side-effect is not taught in the cited art, there is no motivation to combine their teachings as the Examiner has suggested. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

2. There is No Reasonable Expectation of Success

In addition, there is no reasonable expectation of success that the modification that the Office Action contemplates will succeed. "Both the suggestion and the expectation of

success must be found in the prior art, not the Applicants' disclosure." *In re Dow Chem. Co.*, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988).

Applicants submit that the Examiner has used impermissible hindsight reconstruction of the present invention to pick and choose the cited art. However, in combining the references, there is no reasonable expectation that the modification would succeed.

One objective of the present invention is to use tamsulosin or its salt in enteric sustained-release fine particles that can be used for tablets that disintegrate in the buccal cavity as it is necessary to prevent sudden dissolution in order to control the adverse effect of orthostatic hypotension. Specifically, an object of the invention is to realize a tablet dissolution rate at a pH of 1.2, two hours after starting the test of 25% or less and to realize a 50%-dissolution time at a pH of 6.8 of 0.5 to 5 hours. The tablets as claimed successfully inhibit dissolution during the early stages of dissolution tests, but avoid excess inhibition of dissolution during the final stages of dissolution tests. As there is no reasonable expectation that the modification that the Office Action contemplates will succeed, the combination of references fails to render the instant claims obvious. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

3. The Cited Art References Do Not Teach All Limitations of the Claims

The prior art references must teach or suggest all the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970). Applicants assert that the cited art references do not teach or suggest all the limitations of the claims and therefore, the obviousness rejection is untenable.

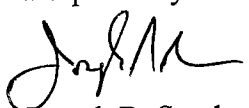
The present invention provides particles used in tablets of tamsulosin or a salt that exhibit good disintegration in the buccal cavity and obtain a dissolution profile that is appropriate. These limitations are not taught or suggested in the combination of references. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



Joseph R. Snyder
Reg. No. 39,381

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 925-472-5000
Fax: 415-576-0300
JS:js
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